



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,032	04/03/2001	Richard A. Steenblik	40669/201349	3794

23370 7590 05/24/2004

JOHN S. PRATT, ESQ  
KILPATRICK STOCKTON, LLP  
1100 PEACHTREE STREET  
SUITE 2800  
ATLANTA, GA 30309

EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/826,032

Applicant(s)

STEENBLIK ET AL.

Examiner

Thong Q Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 14-28, 39-46, 53, 54, 78-95 and 98-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 14-28, 39-46, 53, 54 and 78-95 is/are allowed.
- 6) ☒ Claim(s) 98-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The present Office action is made in response to the amendment filed on 1/10/2004. It is noted that in the mentioned amendment, applicant has amended claim 98 and canceled claims 96-97 and 102. The remaining pending claims 1-5, 14-28, 39-46, 53-54, 78-95 and 98-101 are examined in this Office action.

### ***Allowable Subject Matter***

2. In the previous Office action, claim 98 is indicated by the Examiner as a dependent claim which would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. While the claim 98 is rewritten as an independent claim in the amendment filed on 1/10/04; however, applicant has failed to include all of the limitations of the base claim(s) into the new independent claim. Since the device as recited in the newly-amended claim 98 is broader than in scope in comparison to the device as claimed in the original claim 98; therefore, the indicated allowability of claim 98 and its dependent claims 99-101 is withdrawn in view of the newly discovered reference(s) to Nagasawa (Patent No. 5,886,813). Rejections based on the newly cited reference(s) follow.

### ***Claim Objections***

3. Claim 98 is objected to because of the following informalities. Appropriate correction is required.

The claim recites the feature thereof "the lenses may be re-positioned...for viewing" (lines 4-5); however, the use of the terms "may be" in the mentioned

feature renders the claim indefinite because it is unclear whether the component(s)/function(s) appeared after such terms is/are the positive component(s)/function(s) of the device claimed or not. Should the phrase "may be" be changed to —are— or other positive term(s) to make the claim comply with the requirement of 35 USC 112?

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 98-99 and 101 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagasawa (U. S. Patent No. 5,886,813).

Nagasawa discloses a microscope. The microscope as described in columns 3-6 and shown in figure 1 comprises a frame (100) having a top cover for supporting a revolver (18) which supports a plurality of objective lenses (3) of different magnification and a bottom cover for supporting a stage 91) which in turn supports a specimen. The objective lens of a particular magnification is able to rotate or place in the optical path of the microscope by a rotation of the revolver. Regarding to the slide recited in the claim 98, it is inherent that the specimen is able to place in a slide which slide is supported by the stage.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 2872

7. Claim 100 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasawa in view of either Emmel (U.S. Patent No. 4,483,589) or Hashimoto et al (U.S. Patent No. 4,486,078).

The revolver supporting a plurality of objective lenses of different magnification wherein an objective lens of a particular magnification is able to position in the optical path of the microscope provided by Nagasawa does not explicitly comprises detents for the purpose of providing stops for the positions of the objective lenses. However, the use of a mechanism having detents or protrusions-and-grooves for the purpose of providing positively stops for the positions of the objective lenses is known to one skilled in the art as can be seen in the microscope having a rotating revolver supporting plural objective lenses provided by either Emmel (see columns 3-4) or Hashimoto et al (see columns 1-2). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the microscope having a revolver supporting a plurality of objective lenses of different magnification wherein an objective lens of a particular magnification is able to position in the optical path of the microscope provided by Nagasawa by using a mechanism having detents or protrusions-and-grooves as suggested by either Emmel or Hashimoto et al for the purpose of providing stops for the positions of the objective lenses.

***Allowable Subject Matter***

8. Claims 1-5, 14-28, 39-46, 53-54 and 78-95 are allowed.

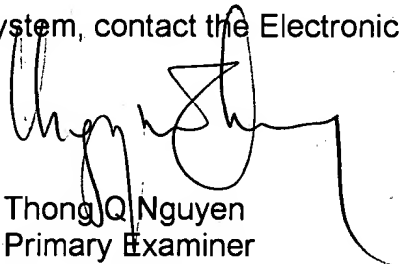
Art Unit: 2872

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen  
Primary Examiner  
Art Unit 2872

\*\*\*